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Brian J. Cragun

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IBM CORPORATION, INTELLECTUAL PROPERTY LAW  
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LUDWIG, MATTHEW J

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BRIAN J. CRAGUN, CHRISTINE A. GREV, and CALE T.  
RATH

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Appeal 2008-006215  
Application 10/731,080  
Technology Center 2100

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*Before* ST. JOHN COURTENAY III, THU A. DANG, and DEBRA K.  
STEPHENS, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## I. STATEMENT OF CASE

Appellants appeal the Examiner's final rejection of claims 1-4, and 6-20 under 35 U.S.C. § 134(a). Claim 5 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

## A. INVENTION

According to Appellants, the invention relates to the field of data entry and retrieval and, more particularly, to annotating a variety of heterogeneous data object types (Spec. 1, ¶ [0002]).

## B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and reproduced below:

1. A method for selecting an annotation structure for use in entering annotation data, comprising:

receiving a request from a user to create an annotation for at least one data object identified by a set of identifying parameters; and

retrieving, from a configuration file, information identifying at least one annotation structure associated with the at least one data object based, at least in part, on the set of identifying parameters and a role of the user, the annotation structure defining one of more annotation fields into which annotation data will be entered.

### C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Gupta                      US 6,956,593 B1                      Oct. 18, 2005

Claims 1-4 and 6-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta.

### II. ISSUE

Has the Examiner erred in finding that Gupta would have suggested retrieving “information identifying at least one annotation structure ..., the annotation structure defining one of more annotation fields into which annotation data will be entered” (claim 1), as Appellants contend?

### III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

#### *Gupta*

1. Gupta discloses a structure for an annotation entry 180 that is maintained by annotation server 10 in annotation meta data store 18, wherein the annotation entry 180 includes a plurality of annotation fields and wherein each of fields 182-204 is a collection of data which define a particular characteristic of annotation entry (col. 7, ll. 28-39; Fig. 4).
2. Annotation identifier field 194 stores data that uniquely identifies annotation entry 180, related annotation identifier field 196 stores data that uniquely identifies a related annotation, while set identifier field

198 stores data that identifies one or more sets to which annotation entry 180 belongs (col. 9, ll. 1-16).

3. Which set an annotation belongs to is identified as whether the set is “instructor’s comments”, “assistant comments”, “audio comments”, “student questions”, and each student’s personal comments (col. 9, ll. 19-25).

#### IV. ANALYSIS

##### *Claims 1-4, 6, and 11-17*

As to independent claims 1 and 11, Appellants merely repeat the language of claim 1 and assert that “[t]he cited section [of Gupta cited by the Examiner] merely shows a field of an annotation” and thus “contains no description of a further annotation structure which defines one or more annotation fields into which annotation data will be entered” (App. Br. 11-12). However, the Examiner finds that “[t]he limitation of ‘annotation structure defining one or more annotation fields into which the annotation will be entered’ is taught in Gupta as ‘annotation identifier field 194’ which uniquely identifies a related annotations[sic]” (Ans. 15) .

Accordingly, we determine whether the Examiner erred in finding that Gupta would have suggested retrieving “information identifying at least one annotation structure ..., the annotation structure defining one of more annotation fields into which annotation data will be entered” as recited in claim 1.

We give the claims their broadest reasonable interpretation. *See In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004). Moreover, we will not read

limitations from the Specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Claim 1 does not place any limitation on what an “annotation structure” means, includes, or represents, other than reciting that the “the annotation structure defining one or more annotation fields into which annotation data will be entered.” In fact, claim 1 does not even define what an “annotation field” is. We therefore interpret “annotation structure” as any structure that defines an annotation field (one or more annotation fields), wherein a field, given its ordinary meaning, can be any unit of a group.

Gupta discloses a structure for an annotation entry which includes a plurality of annotation fields (FF 1), wherein the fields are defined as “annotation identifier”, “related annotation identifier”, “set identifier” or the like (FF 2). We agree with the examiner that “the annotation structure defining one or more annotation fields” reads on Gupta’s annotation identifier field (Ans. 15). That is, Gupta’s annotation identifier field is a structure into which annotation data will be entered, wherein the annotation identifier field defines the field as “annotation identifier” out of a group of fields. Thus, contrary to Appellants’ arguments, the annotation identifier field is an annotation structure which defines “one or more annotation fields” (emphasis added).

Accordingly, we affirm the rejection of independent claim 1, independent claim 11 falling therewith and claims 2-4, 6, and 12-17 respectively depending therefrom under 35 U.S.C. § 103(a) as being unpatentable over Gupta.

Although Appellants adds a new argument in the Reply Brief that “examples of set names do not teach the separate elements of a ‘set of

identifying parameters’ and a ‘role of the user’” (Reply Br. 3, emphasis omitted), this argument could have been raised in the Appeal Brief. That is, the Examiner’s Answer contains the same findings as those set forth in the Final Rejection, and thus, does not necessitate this new argument by the Appellants. It is inappropriate for Appellant to discuss for the first time in the Reply Brief matters that could have been raised in the Appeal Brief. “The failure to raise all issues and arguments diligently, in a timely fashion, has consequences.” *Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative decision). *Cf. Kaufman Company v. Lantech, Inc.*, 807 F.2d 970, 973 n.\* (Fed. Cir. 1986) and *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986).

*Claims 7-10*

As to claim 7, Appellants argue that “*Gupta* merely discloses a user interface ... that is displayed before a user selects data to annotate and the user interface for entering annotation information receives a user request to add an annotation” (App. Br. 12). Thus, according to Appellants, “*Gupta* does not teach, show or suggest generating based on an annotation structure, an interface for entering annotation information to be associated with the specified set of data points” (*id*), as required by claim 7.

We agree with Appellants. In particular, we find that the sections of *Gupta* relied upon by the Examiner does not disclose any generation of an interface based on the annotation structure, as required by claim 7. Rather, as Appellants contend, the user interface of *Gupta* is displayed before the annotation structure is added.

Accordingly, we reverse the rejection of independent claim 7 and claims 8-10 depending therefrom under 35 U.S.C. § 103(a) as being unpatentable over Gupta.

*Claims 18-20*

As to claim 18, Appellants contend that “Gupta does not describe identifying at least one annotation structure associated with at least one data point based on a set of identifying parameters and a role of the user” (App. Br. 13). However, the Examiner finds that Gupta teaches “the available media content such as ‘comments’ or ‘questions’ as identifying parameters, and ‘instructor,’ ‘assistant,’ or ‘student’ as roles of the users” (Ans. 15 ).

Though Appellants argue in the Reply Brief that “even assuming, *arguendo*, that such examples could be construed as teaching a ‘set of identifying parameters’ and a ‘role of the user,’ Gupta does not teach using them as a basis to retrieve any information” (Reply Br. 3, emphasis omitted), such argument is not commensurate in scope with the language of claim 18. That is, claim 18 does not recite any such “using them as basis to retrieve” limitation.

Since Appellants do not provide any argument to dispute that the Examiner has correctly shown where this claimed element is suggested in Gupta, we find that the Examiner did not err in rejecting claim 18 over Gupta. Accordingly, we affirm the rejection of claim 18 and claims 19-20 depending therefrom under 35 U.S.C. § 103(a).

V. CONCLUSIONS

Appellants have not shown that the Examiner erred in concluding that claims 1-4, 6, and 11-20 are unpatentable over Gupta.



Appellants have shown that the Examiner erred in concluding that claims 7-10 are unpatentable over Gupta.

## VI. DECISION

The Examiner's decision rejecting claims 1-4, 6, and 11-20 under 35 U.S.C. § 103(a) is affirmed, and the Examiner's decision rejecting claims 7-10 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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